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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,714	04/10/2001	Donald Ray Denton	PARK.P0148US	1788
49458	7590	07/11/2006		
DON W. BULSON (PARKER HANNIFIN) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE / 19TH FLOOR CLEVELAND, OH 44115			EXAMINER CECIL, TERRY K	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,714

Applicant(s)

DENTON ET AL.

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-16-2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-77; 79-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-77; 79-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- * 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>6-27-2006</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Rejections - 35 USC § 103***

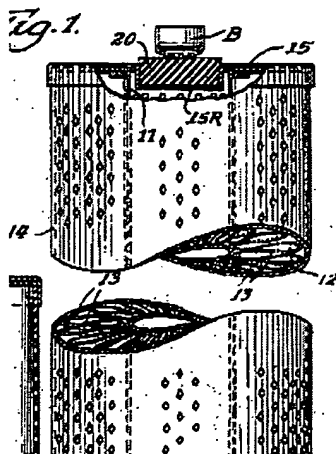
1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 66-75, 77, 79-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonnell (U.S. 3,516,549) in view of MacDonnell (U.S. 3,506,475) and Kahlbaugh et al. (U.S. 6,165,572) and Miller et al. (U.S. 5,552,048). MacDonnell '549 discloses a filter element including pleated filter media 13 and an exoskeleton support screen 14 having a width approx.

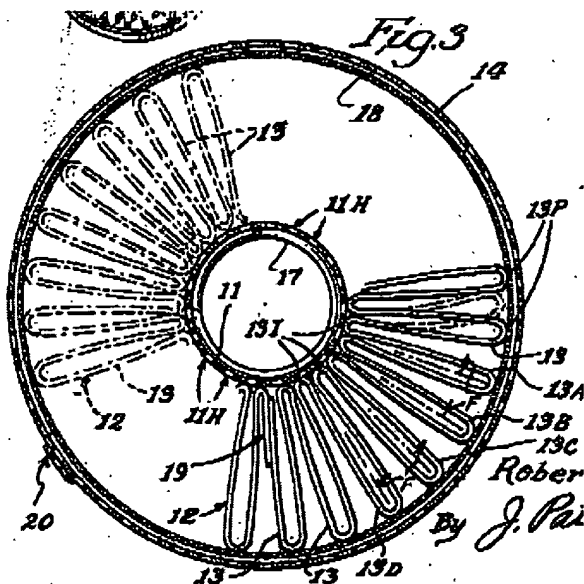


equal to the axial dimension of the filter media. The element is characterized by the absence of support structure surrounding the support screen [as in claim 66].

MacDonnell '549 doesn't teach the screen being thermally-bonded

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to the radially-outer peaks of the filter media, providing an at least 50% open flow area, and providing a tight array of attachment points supporting the pleats in an appropriately spaced and non-collapsed condition, but such is taught by MacDonnell '475. MacDonnell '475 teaches a fuel filter for removing



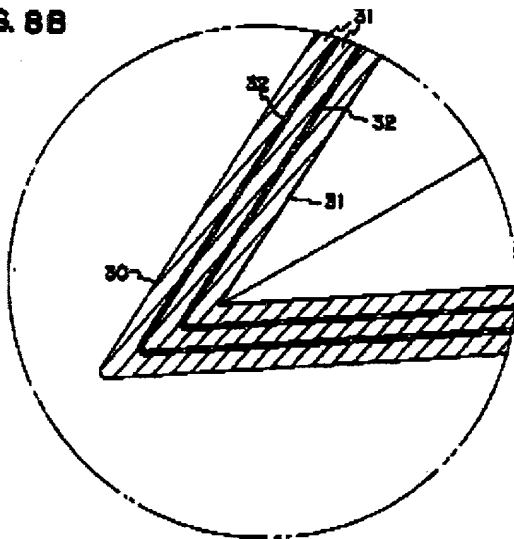
particulates as small as 5 microns or smaller (col. 1, lines 45-46; col. 2, lines 37-38) [as in claim 77]. The filter is cylindrical (figure 1) and includes longitudinally-extending pleats without an endoskeleton for support. An exoskeleton 18 in the form of a netting is attached to each of the outer pleats by an thermo-setting adhesive and a heating plate

(col. 5, lines 26-40) [as in claim 66]. The filter includes about 9.2 pleats per diameter inch (60 pleats/6.5 diameter inches, see col. 9, lines 26-27) [as in claim 67]. As indicated in col. 9, lines 1-4, the netting 18 is for mechanically-ganging the pleats together and has a large-sized mesh to insure *full flow* action through the filter (it is obvious that such would require at least 50% open flow area to allow for the desired full flow through the filter; the exact flow area percentage is a matter of optimization for the desired filter operating characteristics) [as in claim 66]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the bonded exoskeleton support screen of MacDonnell '475 for the exoskeleton of MacDonnell '549, since '475 teaches the benefit of ganging the pleats to cause a flexing action preventing a permanent pleat collapse.

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MacDonnell '475 teaches a pleated formed of fibrous sheet material that can be any one of or a combination of materials, including cotton, wood or *synthetic* (cellulose-free) fibers; but he does not teach a fiberglass (or polymer) filtration layer sandwiched between inner and outer layers of non-woven polymer.

The modified MacDonnell doesn't teach filter *layers* of only cellulose-fiber-free and woven-mesh-free layers that consist of essentially inner, outer, and filter layers but such is taught by Kahlbaugh. Kahlbaugh teaches a multi-layer fibrous pleated media for filtering gases or liquid

FIG. 8B

including fuel (col. 4, lines 48-52; col. 29, lines 25-56), wherein any of the inner layers are sandwiched between adjacent layers and wherein the layers are made of nonwoven polymer fibers (e.g. polypropylene or polyamide) or fibers of glass (col. 16, lines 61-63) [as in claims 66-69 and 71]. Kahlbaugh also teaches fibers with the "Reemay"

trademark, as in the applicant's specification; preferred arrangements having a pleat density of 1-15 pleats/per diameter inch (col. 25, lines 10-16); and an example filter construction consisting of a 3-layer pleated media of micro-glass fibers that demonstrates the superiority over a cellulose-type media (see Experiment 4, col. 36). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the pleated multi-layer media of Kahlbaugh as the media of the modified MacDonnell, since Kahlbaugh teaches

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the benefit of a filter media that can be specifically configured and constructed to provide relatively long life in relatively efficient systems (col. 7, lines 9-13), e.g. the filter can have an efficiency of 99% in fuel filtering systems (col. 29, lines 40-45).

Kahlbaugh also teaches that each coarse layer sandwiching a fine fiber layer is no greater than 0.030 inches (col. 15, lines 30-35) and preferably .001-.010 (col. 3, lines 55-57)[as in claims 70-71].

As for claim 79, it is contended that the invention of MacDonnell as modified above to have the claimed filter media would have the ability to perform as a coalescer element.

Though the modified MacDonnell doesn't teach the support 18 to include a seam allowance, he teaches outerwrap 14 to include a seam allowance 20 (figure 3) such that would skilled in the art would know to include a seam allowance when manufacturing the element when the support 18 is initially in sheet form. MacDonnel doesn't teach the support to be thermally-bonded to the pleats. However, such is known in the art of Miller. As shown in figure 9 and explained in col. 11, line 59 to col. 12, line 6, Miller teaches his exoskeleton to be made of a polymeric mesh (thermally-bondable) that is heat-bonded to his filter pleats. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the exoskeleton of MacDonnel '475, as modified by MacDonnel '549 and Kahlbaugh to be made of the material as in Miller, since Miller teaches the advantage of not requiring adhesive, which would save material costs and simplify manufacture. Miller also teaches the concept of

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overlapping (figure 6) and extending the support the full axial length [as in claims 73-74]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to having the support of MacDonnell to have overlapping (a seam allowance) as in Miller in order to have the benefit of provide adequate support for the filter element during operation. Upon modification, the lateral seam of support 18 would extend parallel to the longitudinal axis of the filter media and would itself be heat-fused [as in claim 75]. As for claim 72, the relative spacing between e.g. the longitudinal screen cords of support 18 and the pleat spaces thereof is considered to be within ordinary skill in view of Millers teaching that gird size is chosen depending upon “the properties of the fluid to be filtered, the flow rate, and other factors” as taught by Miller in col. 11, lines 63-65.

As for new claims 80-87, the modified MacDonnell (U.S. 3,516,549) teaches all the limitations thereof including the additional limitations of bounded end caps. MacDonnell '549 teaches a bonded end cap but doesn't specify an embodiment wherein both end caps are bonded to the ends of the element. However, such is taught by Miller (col. 4, lines 2-10). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have both end caps of MacDonnell to be bounded to the ends of the filter element, since such would provide additional support for the element to resist e.g. skewing forces applied thereto.

MacDonnell teaches a core 11 circumscribed by the element [as in claim 84]. As for the use of “consisting essentially of” for the transitional word of the claim, applicant is reminded that “it is proper for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel

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characteristics actually are, 'consisting essentially of' will be construed as equivalent to 'comprising'." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. In this case since applicant's inventions include embodiments with or without the core, claim 80 does not preclude the additional structure of a central tube therewith. However, because of the disclosure, cellulose-fiber and woven mesh endoskeleton support layers in the filter media are precluded.

3. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonnell, as modified above, and in further view of Wylie et al. (U.S. 6,331,223). Wylie teaches a screen material that is made of PVC coated fiberglass (col. 1, line 66 to col. 2; line 6. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the modified screen of MacDonnell to be made of the material of Wylie, since Wylie teaches the benefit of a screen material that is heat-fused and that is most popular (which would have the benefit of likely availability).

Response to Arguments

4. Applicant's arguments filed 4-25-2006 have been fully considered but they are not persuasive.

- Applicant argues that the netting of '475 could not function as an exoskeleton support since '475 only teaches his netting to be in combination with wrap 14. This is not found to be convincing since the netting does provide support to the pleated filter material—as in col. 9, which teaches that because of the netting, operating pressures of 125 psi rather than the conventional 60 psi are possible before a bypassing condition is necessary.

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- In addition, the scope of the independent claims of '475 do not require the wrap.
- Also, it is pointed out that '549 does not require his exo-structure to be only metal, see col. 3.
- It is also presented that the filter element of '549 when modified as above would be the same as the applicant's and would therefor have the same ability to support the pleats as applicant asserts—without requiring an additional wrap.

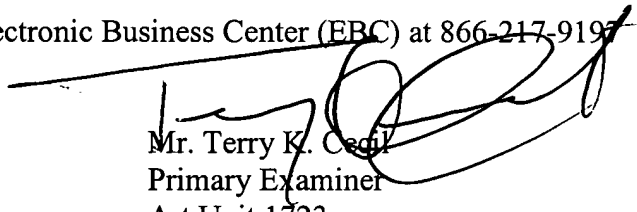
Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9195 (toll-free).



Mr. Terry K. Cecil
Primary Examiner
Art Unit 1723

TKC
July 5, 2006